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09/583,336

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05/15/2008

EXAMINER

NGUYEN, TRAN N

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/583,336	Applicant(s) REEVES, WILLIAM F.	
	Examiner Tran Nguyen	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

This communication is in response to the communication filed 03/19/2008.

Pending claim(s): 58-77. Cancelled claim(s): 1-57. Amended claim(s): 58, 60, 64, 66-68, 71, 73-75.

Response to Amendment

As per the rejection of claims 58-77 under 35 USC 112, second paragraph impose in the previous Office Action, this rejection is hereby withdrawn in view of Applicant's amendment to claims 58, 66, 68.

The attempt to incorporate subject matter into this application by reference to application 09597107 is ineffective because the referenced application is filed later than the instant pending application.

Examiner acknowledges Applicant's comments on page 5 of the communication filed 07/17/2007 indicating that the referenced application was delayed "due to a clerical error by the applicant's office manager".

Because this error was not committed by the USPTO, Examiner does not have proper authority at this time to grant Applicant an earlier filing date to the referenced application.

On page 9 of the Remarks filed 03/19/2008, Applicant asserts that the amended feature as supported by the referenced application provides a basis for patentability.

This assertion is taken to indicate essential subject matter drawing support from the referenced application. See MPEP 608.01(p)(I).

The incorporation by reference will not be effective until correction is made to comply with 37 CFR 1.57(b), (c), or (d). If the incorporated material is relied upon to meet any outstanding objection, rejection, or other requirement imposed by the Office, the correction must be made within any time period set by the Office for responding to the objection, rejection, or other requirement for the incorporation to be effective. Compliance will not be held in abeyance with respect to responding to the objection, rejection, or other requirement for the incorporation to be effective. In no case may the correction be made later than the close of prosecution as defined in 37 CFR 1.114(b), or abandonment of the application, whichever occurs earlier.

Any correction inserting material by amendment that was previously incorporated by reference must be accompanied by a statement that the material being inserted is the material incorporated by reference and the amendment contains no new matter. 37 CFR 1.57(f).

The amendment filed 03/19/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The newly added limitation in claim 58 recites “means of simultaneously transmitting data and electrical power to and from said storage device during said

docking or porting via either contacts or non-contact capacitance or inductance contacts". Claim 68 recites similar limitations.

Examiner acknowledges that on page 9 of the Remarks filed 03/19/2008 Applicant asserts support for these limitations in application 09597107; however, for the reason discussed above, the incorporation by reference is ineffective. Therefore, the amendment constitutes new matter, and lacks any support for these newly added limitations in the specification as originally filed.

Applicant is requested to clarify the issues discussed above, to specifically point out support for the newly added limitations in the originally filed specification and claims to the extent possible, and to cancel any new matter in the reply to this Office Action.

Specification

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 USC 112, first paragraph for at least the same rationale as discussed above, and incorporated herein.

Claim Rejections - 35 USC § 112

Claim(s) 58-77 is/are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

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which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claim(s) 58, 68, these claims are rejected for at least the same rationale as discussed above, and incorporated herein.

As per claims 59-67, 69-77, these claims fail to remedy the deficiencies of parent claims 58, 68, and are therefore rejected for at least the same rationale above through dependency.

NOTE: The rejection presented hereinbelow is for Applicant's consideration should Applicant properly traverse the new matter issues discussed above in the response hereto.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 58-77 is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 58, this claim recites "contact or non-contact capacitance or inductance contacts". The grammar of this limitation renders the scope of the claim indefinite.

For purposes of applying prior art, Examiner interprets this limitation to recite:

- (a) contact capacitance,
- (b) non-contact capacitance, or
- (c) inductance contacts.

Claim 58 further recites:

(a) "means of providing electrical power to said storage device from... a power source stored in said device";

(b) "means of simultaneously transmitting data and electrical power to and from said storage device... via... non-contact capacitance".

Because Applicant recites optional limitations, Examiner submits that this combinatorial logic of the optionally recited elements renders the scope of the claim indefinite because it is not clear how a power source stored in the device can transmit power to the device via non-contact capacitance.

Does Applicant intend to recite onboard power supply capable of providing power via non-contact capacitance, or does Applicant intend to recite that only external power supply can operate via non-contact capacitance?

Additionally, the limitation "means of simultaneously transmitting data and electrical power to and from said storage device... via either contact or non-contact capacitance or inductance contacts" is indefinite because it is not clear if Applicant intends to limit data and power transmission to the same means, or if data and power transmission can be performed with different means.

For purposes of applying prior art, Examiner, in applying the broadest and most reasonable interpretation in view of the specification and the level of ordinary skill in the art, interprets this limitation as follows:

"means of simultaneously transmitting data and electrical power..., wherein data transmission and electrical power transmission each is performed via at least one of:

- (a) contact capacitance,
- (b) non-contact capacitance, or
- (c) inductance contacts".

All claims dependent thereon, namely claims 59-67 fail to remedy these deficiencies, and are therefore rejected for at least the same rationale above, and incorporated herein.

As per claims 68-77, these claims are rejected for at least the same rationale as applied to claims 58-67 above, and incorporated herein.

Additional clarification is requested.

Claim Objections

Claim 58 is objected to because of the following informalities: page 3 contains a period ".". The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Appropriate correction is requested.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 58-62, 64, 66, 68-71, 73-74, 76-77 is/are rejected under 35 U.S.C. 102(b) as being anticipated by Yeager (WO 97/22297, copy provided in the Office Action mailed 06/21/2002).

As per claim 58, Yeager teaches a computer system for storing, retrieving, and organizing digital medical records and other vital personal information from bodily worn or carried storage devices, the system comprising:

(a) a storage device that is carried or worn capable of storing digital medical records and other vital personal emergency information of the user (page 3 line 14-16);

(b) built-in power (reads on “means of providing electrical power to said storage device from... a power source stored in said device”) (page 6 line 30).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

Yeager further teaches:

(c) means for rapid access, reading, writing, erasing, and updating of said digital medical records and personal data of said user stored in said portable device (page 3 line 22 to page 4 line 2);

(d) means for docking or porting said storage device to portable or stationary computer devices to access, view and manage said records and personal information (page 5 line 17-26);

(e) built-in power (reads on “transmitting... electrical power... via... inductance contacts”) (page 6 line 30) and Dallas Semiconductor 19XX family of Touch Memory devices (reads on “transmitting data... via... inductance contacts”) (page 7 line 17-19), wherein memory is SRAM or EPROM (reads on “simultaneously transmitting data and electrical power”) (page 7 line 5-6);

(f) means for recognizing and authenticating said storage device, via a unique digital identifier unique to said storage device and stored in said storage device, when said storage device is ported to said computer devices (page 5 line 29, page 7 line 11-13, page 12 line 4-6);

(g) means for bi-directional flow of data to and from said storage device from any of said computer devices (page 11 line 9 to page 12 line 7);

(h) means to access, display, and update said digital records within said storage device via a wireless telecommunications modality (page 5 line 18-21).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

Yeager further teaches:

(i) unique markings on the exterior of said portable device indicating it contains said medical records or vital personal information of said user (Figure 2, note the medical symbol included on the bracelet);

(j) means to organize said records and vital personal information in page or template format for ease of viewing and use (page 7 line 23-27).

As per claim 59, Yeager teaches said storage device and said computer devices are enclosed in a rugged, weatherproof case or enclosure (page 6 line 15-18).

As per claim 60 teaches said storage and access of said digital records from said data storage device is via non-volatile memory (page 7 line 4-8).

As per claim 61, Yeager teaches said portable computers include at least other portable computer devices (page 5 line 18-20).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

As per claim 62, Yeager teaches said stationary computers include at least personal computers (page 5 line 5-9).

As per claim 64, Yeager teaches said portable storage device contains software for seamless and rapid communication and transfer of data to and from said computer devices (page 13 line 17-21).

As per claim 66, Yeager teaches said means for porting includes porting connections including at least other porting modalities (page 8 line 5-6).

It is noted that Examiner adopts the interpretation discussed in on page 3 paragraph 8 of the previous Office Action, and incorporated herein: "For the purpose of applying art, Examiner interprets this limitation to recite "wherein said means for porting includes a porting connection including at least one of serial ports, optical ports, docking stations, USB ports, and other porting modalities.'""

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

Claims 68-71, 73-74, and 76-77 recite substantially similar limitations to those addressed in claims 58-62, 64, and 66, and, as such, are rejected for similar reasons as given above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 63, 65, 67, 72 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeager in view of Linder (6681003).

As per claim 63, Yeager does not teach “said digital records and personal information are encrypted for security and to limit access to authorized system users”.

Linder teaches a portable storage device that stores digital patient records and wherein said digital records and personal information are encrypted for security and to limit access to authorized system users (column 3 line 54-55).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Linder within the embodiment of

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Yeager with the motivation of providing enhanced protection for sensitive patient information.

As per claim 65, Yeager does not teach linking said storage device and said computer devices to a website and said digital records and personal information are accessible from a website via a security password unique to said portable device user.

Linder teaches linking a storage device and computer devices to a website and utilizing a security password to access information at the website (column 3 line 45-61).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Linder within the embodiment of Yeager with the motivation of providing enhanced protection for sensitive patient information.

As per the set of claim(s): 67, 72, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 65, 63, respectively, and incorporated herein.

Claim(s) 75 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeager in view of Applicant Admitted Prior Art (AAPA).

It is noted that the official notice taken in the previous Office Action is taken to be AAPA because Applicant failed to adequately traverse Examiner's assertion.

As per claim 75, Yeager not teach performing the authentication by comparing a biometric characteristic of said user that is stored in said storage device to a database of said user biometric characteristics stored in said computer system.

AAPA teaches that authentication through biometric characteristic comparison is old and well known in the art. For example, it was old and well known in the art to perform fingerprint biometric authentication at the time of the invention.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of AAPA within the embodiment of Yeager with the motivation of providing enhanced security to sensitive patient information.

Response to Arguments

Applicant's arguments filed 03/19/2008 have been fully considered but they are not persuasive.

As per claim 58, on page 10 Applicant argues that the applied art do not teach "simultaneous transfer of data and power and from his storage device during porting or docking using non-contact or contact capacitance or inductance elements".

Examiner notes the interpretation adopted above for purposes of applying prior art, and incorporated herein.

Yeager teaches using built-in power (page 6 line 30) to maintain volatile SRAM (page 7 line 5-6). Yeager further teaches EPROM (page 7 line 5-6).

It is inherent that this type of volatile memory needs power to maintain the stored data. As a result, power is always supplied to the memory.

Therefore, when a memory read is performed, it is inherent that data and power are transmitted at the same time to and from the memory because if power is not continuously transmitted to the memory, the memory would eventually lose the stored data.

Notwithstanding the above, and while Examiner acknowledges that EPROM is non-volatile, and to some extent SRAM also exhibits some data remanence, i.e. data is still stored on the SRAM after power is removed, all memories are capable of being powered at any time, including during a data read. It is further noted that one of ordinary skill in the art relying on the data remanence of SRAM would find unpredictable results in the retrieved data because data deteriorates after the removal of power. Therefore, it is clear that power should be applied constantly to SRAM, and that EPROM is also capable of being powered during a data read.

Additionally, on page 10 Applicant admitted that Yeager uses a steel shell of the storage device as a conductor that allows data to be transmitted through the shell to the probe via physical contact.

Examiner submits that the "inductance elements" recited by Applicant refers to an inherent characteristic of all electrical contacts. In particular, any time during electron motion through a circuit, a magnetic field is created, and hence, a magnetic flux. Self-inductance is an inherent characteristic of any electronic circuit. Therefore, the steel shell of Yeager is considered to be "inductance contacts".

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

Examiner further considers the probing of the shell to be "docking or porting".

Based on the evidence presented above, Examiner submits that the applied art anticipate Applicant's claimed invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Davis (4941201) teaches a powering a device externally during docking with a computer.

The new ground(s) of rejection presented in this Office action, if any, was/were necessitated by Applicant's amendment. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./
Examiner, Art Unit 3626
04/28/2008

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/Robert Morgan/
Primary Examiner, Art Unit 3626